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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/241,989	02/02/99	SUZUKI	M JA992-011-(8
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MM12/0702

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EXAMINER

DUDEK, J

ART UNIT

PAPER NUMBER

2871

DATE MAILED: 07/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/241,989

Applicant(s)
Suzuki et al

Examiner
James Dudek

Group Art Unit
2871



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-7 is/are allowed.

☒ Claim(s) 8-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

Reissue Applications

1. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 10 claims the optical film further including means for increasing illumination within and decreasing illumination outside of a viewing angle of about 35 degrees in the vertical direction and about 55 degrees in the horizontal direction of the liquid crystal. The specification discloses that the optical film is made of transparent material having a rough surface and a second surface of isosceles triangle prisms. The specification discloses that the angle of the prisms is what controls the illumination inside and outside the viewing angle and no further means is necessary. The specification never discloses the optical film further including a means for increasing the illumination. Since the optical film as defined by the specification as inherently including the prisms, the specification disclosure as originally filed does not disclose a further means.

Art Unit:

Claim Rejections - 35 USC § 251

Claim 10 is rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: see the above rejection under 35 U.S.C. 251.

Recapture Rejection - 35 USC § 251

4. The following is a quotation from the MPEP 1412.02.

The recapture rule bars the patentee from acquiring, through reissue claims that are of the *same or broader scope* than those claims that were canceled from the original application. (See MPEP 1412.02)

5. Claims 8-27 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application.

Claim 8 claims "An optical film of light transparent material including a first surface having an optically rough structure for diffuse-transmitting incident light and a second surface having a wave structure including a plurality of isosceles triangle prisms arranged side-by-side substantially throughout said second surface, the prisms having smooth surfaces for refracting said light diffuse-transmitted from said first surface and directionally distributing said diffuse-transmitted light through said second surface." Claim 9 adds to claim 8 the top angle of the isosceles triangle prisms is in a range of about 90 degrees to about 120 degrees.

Claims 8 and 9 limitations are found in originally filed claims 1-2. Claims 1-2 claim "An optical film of transparent material, comprising: a first surface having a wave structure including a plurality of isosceles triangle prisms arranged side-by-side, and a second surface having an optically rough structure for performing diffuse transmission." Claim 2 adds a top angle of said isosceles triangle prisms is in the range of 90 degrees to 120 degrees.

Prosecution history of claims 1-2 follows. The originally filed claims 1-2 were rejected in paper number 6 of patented application. The applicant then canceled claim 2 and amended claim 1 by adding a range of 95 degrees to 120 degrees (paper number 8). The applicant later added to claim 1 the prisms having smooth surfaces (paper number 13). The Examiner then finally rejected

Art Unit:

claim 1 which included the smooth prism and range of 95-120. After an interview with the Applicant's representative, the Examiner indicated that the claims as amended appear to be allowable (paper number 15) in the amendment the applicant canceled claims 1, 3, 6, 9, 13 and 15-21. The amended claims included a range of 95 degrees to 120 degrees and the applicant argued the criticality of this range (which the specification disclosure supports) in paper number 16. The prosecution history clearly shows claims that were canceled or amended which are now sought by the Reissue application.

Claims 10-12 are also rejected because applicant cannot acquire, through reissue, claims that are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejections.

Regarding claims 13-19 and 24-27, they have similar prosecution history. Claim 13 limitations are found in originally filed non-amended claim 5 which was then amended in paper number 13 and again in paper number 16 which was allowed. Claim 24 limitations are also found in originally filed non-amended claim 5. Claims 9, 14, 18 and 25 limitations are found in originally filed non-amended claim 2. 11's limitations are found in originally filed non-amended claim 7. Claims 16 and 17 limitations are found in originally filed non-amended claim 10.

Again, claims 14-19 and 25-27 are also rejected because applicant cannot acquire, through reissue, claims that are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejections.

Regarding claims 20-23, claim 20 claims an optical film comprising a diffusing means for diffuse transmitting light illuminated proximal to the back portion of the display and refracting means including a plurality of isosceles triangle prisms arranged side-by-side for directionally distribution the diffuse-transmitted light toward the front portion of the display for increasing luminance of light within a viewing angle of about 35 degrees in the vertical direction and about 55 degrees in the horizontal direction of the front portion of the display. These limitation are found in original claims 5-6. The "...increasing luminance of light within a viewing angle of about

Art Unit:

35 degrees in the vertical direction and about 55 degrees in the horizontal direction of the front portion of the display" limitation is inherent. Applicant specification discloses at column 5 that the angle of the prisms is one factor that produces the desired result of increasing luminance of light within a viewing angle of about 35 degrees in the vertical direction and about 55 degrees in the horizontal direction. Thus, a claim claiming an optical film of transparent material, comprising: a first surface having a wave structure including a plurality of isosceles triangle prisms arranged side-by-side, and a second surface having an optically rough structure for performing diffuse transmission, wherein a top angle of said isosceles triangle prisms is in the range of 90 degrees to 120 degrees would inherently increase luminance of light within a viewing angle of about 35 degrees in the vertical direction and about 55 degrees in the horizontal direction.

Accordingly, claims 8-27 are not used to solve an error within the meaning of 35 U.S.C. 251.

Allowable Subject Matter


6. Claims 1-7 are allowed.

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Dudek whose telephone number is (703) 308-4093. The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

James Dudek
July 1, 1999


William L. Sikes
Supervisory Patent Examiner
Technology Center 2800